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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,804	11/24/2003	Richard L. Kulp	GB920030079US1	5413

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EXAMINER
DAM, KIM LYNN

ART UNIT	PAPER NUMBER
2179	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/720,804	KULP ET AL.
	Examiner	**Art Unit**	
	Kim-Lynn Dam	2179	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the following communications: Amendment

and Arguments/Remarks filed on 4/25/07. **This action is made final.**

2.   Applicant amended claims 1-3, 5, 6, 8-20, 22-25, 27, and 29-31. Claims 1-31

stand rejected.

Specification

3.   The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: Claims 28 and 29 recite "a program element" and claims 28-

30 recite a "tangible computer-readable" medium, both of which are not supported by

the specification.

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Claim Objections

4.   Claims 16-27, 28, 29 and 31 are objected to because it is unclear to whether they

are directed to statutory subject matter.

Regarding claim 16, it appears to be directed to a software tool for performing

operations. It is unclear to whether the claim defines any structural and functional

interrelationships between the software tool and other claimed elements of a computer,

which permit the program's functionality to be realized, therefore it may be non-statutory. Depending claims 17-28 do not remedy the potential deficiencies of claim 16, therefore they are also objected.

Regarding claim 28, it appears to be directed to a program element, which amounts to software per se, which may not be tangible to form statutory subject matter.

Regarding claims 29-31, they are directed to tangible computer-readable mediums. It is unclear to whether they are directed to statutory subject matter. Examiner suggests that the claims be directed to storage mediums as disclosed in the specification

Claim 23 is objected to for minor informalities. Line 1 of claim 23 recites "The software tool of claim 16, graphics editing operation...", which is an incomplete sentence. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 31 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 31 is directed to a tangible computer-readable

medium comprising a signal (line 2), which is not tangible to form the basic statutory

subject matter under 35 U.S.C. 101. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 1-3, 5-10, 15-17, 19-24, and 28-32 are rejected under U.S.C. 103(a) as

being unpatentable over Hama et al. (USPN 5,574,277) in view Brown et al. (USPN

5,627,959) and in further view of Applicant's own admitted prior art (Background

section).

Regarding claim 1, Hama disclosed a method for performing an operation on a graphic object in a display of overlapping graphic objects in a data processing system, the method comprising the steps of:

displaying a plurality of overlapping graphic objects to a user (Abstract, lines 1-3; Column 1, line 65 to Column 2 line 9; Fig. 7 and 8);

detecting a position of a pointer with respect to a display of said plurality of overlapping graphic objects (Abstract, lines 3-4; Col. 3, lines 37-39 and 52-59);

displaying to a user a list of overlapping graphic objects which coincide with said pointer position and on which said graphics editing operation can be performed (Abstract, lines 3-13; Col. 3, line 52 to Col. 4 line 3; where editing operation is inherently performed on the selected edit object);

Hama does not specifically teach detecting a selection by the user of one graphic object of said indicated plurality of overlapping graphic objects as a target object without the user changing said pointer position to make said selection. However, selection of an object from a menu or subscreen without the user changing said pointer position, for example keyboard arrow buttons to move along choices and enter button to select, is well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these selection means without changing the pointer position in order to allow the user to make selections without losing their current pointer position.

Hama does not explicitly teach detecting a selection by the user of a graphics editing operation to be performed on a graphic object, performing said graphics editing

operation on said target graphic object; and making said target graphic object visible during performance of the graphics editing operation on said target graphic object. However, these limitations are obvious in view of Hama since Hama teaches selection of an edit object. It is well known in the art that selection and performance of editing operations happen when an edit object is selected as also shown in applicant's own admitted prior art (Background, Page 1, lines 15-20).

Hama does not specifically disclose storing a model of a graphic object, wherein said model includes an indication of whether said graphic object is a parent or child of another graphic object. However, in an analogous art, Brown teaches storing graphic objects with indication of whether an object is a parent or child of another object (Figures 2,3A, 3B, and Figure 4 (layered objects); Column 8, lines 13-25, where layers are defined as children of the root object). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Brown into the system of Hama in order to keep track of related objects.

Regarding claim 2, the rejection of claim 1 is incorporated and neither Hama nor Brown specifically teach wherein said position of a pointer comprises a user-defined area of said display described by the motion of said pointer in response to said user dragging an input device. However, use of a pointer to define an area, for example dragging the input device to draw a box around a selected area, is well known and expedient in the art. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate selecting a user-defined area using a pointer, since
that would allow users to specifically define an area on the display.

Regarding claim 3, the rejection of claim 1 is incorporated and further Applicant's own
admitted prior art disclosed wherein said step of selecting the graphics editing operation
comprises detecting a user input identifying selection of a graphics editing tool
(Background, Page 1, lines 15-22).

Regarding claim 5, the rejection of claim 1 is incorporated and further Applicant's own
admitted prior art disclosed wherein said step of selecting the graphics editing operation
to be performed comprises selecting a source graphic object and said step of
performing the graphics editing operation comprises dropping said source graphic
object onto said target graphic object (Background, Page 1, line 26 to Page 2 line 13,
where selected source object can be dropped onto the target object).

Regarding claim 6, the rejection of claim 1 is incorporated and further Hama disclosed
comprising the step of storing the positions of said plurality of overlapping graphic
objects on said display and comparing said pointer position with said graphic object
positions to determine which graphic objects are coincident with the pointer (Figure 2,
element 3; Col. 2, lines 44-50; Col. 3, lines 42-59).

Regarding claim 7, the rejection of claim 1 is incorporated and further Hama disclosed

comprising the step of maintaining a record of attributes relating to each of said graphic

objects (Figure 2, element 3; Col. 3, lines 47-52).

Regarding claim 8, the rejection of claim 1 is incorporated and further Hama disclosed

wherein said displaying step comprises continuously displaying to the user a hover

window listing said graphic objects which are coincident with said pointer position and

continuously updating said hover window in response to changes in said pointer

position (Abstract, lines 10-11; Col. 2, lines 50-53; Col. 3 line 66 to Col. 4 line 13; Col. 4,

lines 33-36, where contents of hover window change in response to pointer position).

Regarding claim 9, the rejection of claim 1 is incorporated and neither Hama nor Brown

specifically discloses wherein said graphics editing operation comprises adding text to

said target object. However adding text is a graphics editing operation that is well

known and expedient in the art. It would have been obvious to one of ordinary skill in

the art at the time the invention was made to incorporate adding text as a graphics

editing operation to an object, since that allows users to integrate text into the graphics.

Regarding claim 10, the rejection of claim 1 is incorporated and neither Hama nor

Brown specifically disclose wherein said graphics editing operation further comprises

the steps of:

opening a text box on said target graphic object;

displaying a text insertion cursor in said text box to display the location where
new text will be inserted; and

ending said graphic operation in response to the user moving said pointer to a
position outside of said text box and depressing a control button on an input device.
However, these steps taken to add text to objects are well known and expedient in the
art. It would have been obvious to one of ordinary skill in the art at the time the
invention was made to incorporate these steps to add text as a graphics editing
operation to an object, since that allows users to integrate text into the graphics.

Regarding claim 15, the rejection of claim 1 is incorporated and Hama inherently
disclosed wherein said step of displaying an indication of coincident graphic objects is
dependent on said position of the pointer remaining the same for a certain period of
time (Abstract, lines 3-13; Col. 3, line 52 to Col. 4 line 3; where editing operation is
inherently performed on the selected edit object).

Regarding claims 16, 17, 19, 20, 21, 22, 23, and 24, the limitations have been
addressed in the rejection of claims 1, 2, 5, 6, 7, 8, 9, and 10 respectively. Therefore
claims 16, 17, 19, 20, 21, 22, 23 and 24 are rejected under the same rationale as
applied above.

Regarding claim 28 and 29, they are the program element comprising program code for
executing the software tool of claim 16. Therefore claims 28 and 29 are rejected under

the same rationale as applied above.

Regarding claim 30, it is the program element comprising instructions for performing the method of claim 1. Therefore claim 30 is rejected under the same rationale as applied above.

Regarding claim 31, Hama inherently disclosed a solid-state memory.

Regarding claim 32, the rejection of claim 16 is incorporated and Hama discloses a data processing system comprising a software tool according to claim 16 (Figure2).

8.   Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al. (USPN 5,754,177) Brown et al. (USPN 5,627,959), Applicant's own admitted prior art (Background section) and further in view of Keren et al. (USPN 6,335,733).

Regarding claim 4, the rejection of claim 3 is incorporated and neither Hama nor Brown specifically disclose changing the form of said pointer on said display in response to detection of said user input selection. However Keren disclose the above limitation (Col. 5, lines 14-16 and 48-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Keren into the system of Hama in order to allow users to efficiently visualize the interchange of one

operation to another.

Regarding claim 18, the limitations were addressed in the rejection of claim 4.
Therefore claim 18 is rejected under the same rationale as applied above.

9.   Claim 11 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Hama et al. (USPN 5,754,177) in view Brown et al. (USPN 5,627,959), Applicant's own
admitted prior art (Background section) and further in view of Bates et al. (USPN
5,377,314).

Regarding claim 11, the rejection of claim 10 in incorporated neither Hama nor Brown
specifically disclose the step of determining whether said target graphic object is the
outermost one of said graphic objects which are coincident with the position of the
pointer.   However, Bates disclosed the above limitation (Col. 5, line 59 to Col. 6, line 4).
It would have been obvious to one of ordinary skill in the art at the time the invention
was made to incorporate the teachings of Bates into the system of Hama in order to
allow the determination of the outermost object based on the order which objects
appear in the z-axis (Bates Col. 6, lines 2-4).

Regarding claim 25, the limitations have been addressed in the rejection of claim 11.
Therefore claim 25 is rejected under the same rationale as applied above.

10.   Claims 12-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hama et al. (USPN 5,754,177) in view Brown et al. (USPN

5,627,959) , Applicant's own admitted prior art (Background section), Bates et al.

(USPN 5,377,314) and further in view of Frank et al. (USPN 5,651,107).

Regarding claim 12, the rejection of claim 11 is incorporated and neither Hama, Brown,

nor Bates disclose wherein the step of making said target graphic object visible

comprises temporarily making at least the outermost one of said coincident graphic

objects transparent. However, Frank disclosed making coincident graphic objects

transparent (Abstract, lines 17-25). It would have been obvious to one of ordinary skill

in the art at the time the invention was made to incorporate the teachings of Frank into

the system of Hama, Brown and Bates in order to make underlying data or graphics

visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Regarding claim 13, the rejection of claim 12 is incorporated and neither Hama, Brown,

Bates nor Frank expressly teach wherein the outermost coincident graphic object is a

child graphic object to a parent graphic object and the step of making the selected

target graphic object visible comprises temporarily making said parent graphic object

transparent in response to making said child graphic object transparent.   However,

making the parent and child graphic object transparent in order to make the selected

target visible would have been obvious to one of ordinary skill in the art at the time the

invention was made in view of Hama, Brown, Bates and Frank, they all disclose

overlapping graphic objects, Brown teaches parent child graphic relationships and

Frank teaches making objects transparent in order to make underlying data or graphics

visible to users (Bates, Abstract, lines 22-25; Col. 2, lines 49-55).

Regarding claim 14, Frank inherently discloses graphic objects, which reappear

automatically after the operation has been performed on said target object.

Regarding claims 26 and 27, the limitations have been addressed in the rejection of

claims 12 and 13 respectively. Therefore claims 12 and 13 are rejected under the same

rationale as applied above.

Response to Arguments

11.   Applicant is reminded that any citation to specific, pages, columns, lines, or

figures in the prior art references and any interpretation of the references should not be

considered to be limiting in any way. A reference is relevant for all it contains and may

be relied upon for all that it would have reasonably suggested to one having ordinary

skill in the art. In re Heck, 699 F.2d 1331, 1332-33,216 USPQ 1038,1039 (Fed. Cir.

1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA

1968)).

12.   Applicant's arguments filed 4/25/07 have been fully considered but they are not

persuasive. Applicant's arguments with respect to claims 1, 2, 8-10 and 13 have been

considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Conclusion

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim-Lynn Dam whose telephone number is (571) 270-1408. The examiner can normally be reached on M-TH 8:00-5:30, every other Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Kim-Lynn Dam

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